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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------------|------------------------|
| 10/632,794 | 08/04/2003 | Huai-Jen Tsai | 8961-000004/US | 5554 |
| 30596 7590 10/11/2007 HARNESS, DICKEY & PIERCE, P.L.C. P.O.BOX 8910 RESTON, VA 20195 | | | EXAMINER BERTOGGIO, VALARIE E | |
| | | | ART UNIT 1632 | PAPER NUMBER |
| | | | MAIL DATE 10/11/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|---|-------------------|----------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. | Applicant(s) | |
| | 10/632,794 | TSAI, HUAI-JEN | |
| | Examiner | Art Unit | |
| | Valarie Bertoglio | 1632 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 24 September 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): No rejections have been overcome (see below).
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-5.7.8.10-12.
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

/Valarie Bertoglio, Ph.D./
Primary Examiner
AU 1632

Continuation of 3. NOTE: Claim 7 raises new issues for consideration under 35 USC 122, 2nd paragraph as it reads on a product according to the method of claim 3..

Continuation of 11. does NOT place the application in condition for allowance because: The claim amendments have not been entered. Applicant's arguments rely on the proposed claim amendments, with the exception to the rejections of claims under 35 USC 103(a). Applicant's arguments regarding the rejections under 35 USC 103 are not persuasive. Applicant argues that Hsiao does not teach or suggest the use of a red fluorescent protein and that Carvan, while teaching red fluorescent protein, does not teach such in stable transgenics. In response, it is noted that Carvan taught use of golden zebrafish, not red fluorescence. Applicant argues that Carvan taught that there are difficulties in sustaining transgene expression beyond the F2 generation in zebrafish. In response, the phenomenon discussed by Carvan is relevant to use of non-fish promoters and constructs. On the contrary, much success has been found in germline transmission of active transgenes comprising native fish sequences in zebrafish through multiple generations. Carvan is relied upon merely for the suggestion of using golden zebrafish to better visualize fluorescence. With respect to Applicant's arguments regarding the teaching of Opsahl that are applicable to mice, there is no reason to believe this would hold true for fish (see page 12 of the final office action). With respect to position effects, this phenomenon is readily dealt with through obtaining multiple transgenic lines with independent insertion events. As for substitution of DsRed for EGFP, it was standard in the art at the time of filing to interchange any gene encoding a fluorescent protein both in vitro and in vivo and such a specific teaching is not necessary to render obvious the combination of in vivo fluorescence taught by Hsiao et al with the fluorescent gene product encoded by DsRed2 taught by Living Colors. In light of the common, routine and accepted state of the art at the time of filing, there is no evidence suggesting replacing EGFP of Chou et al with DsRed2 of Living Colors would be anything other than routine. It is also noted that the ornamental value of the fish is of no relevance to the instant claims.